

DOCKET NO.: ISPH-0595  
Appl. No. 09/923,515

PATENT

### REMARKS

Claim 1 is currently amended, Claims 2-4, 6, 8, 11, 14, and 16-20 are canceled without prejudice, and Claims 21-40 are newly introduced. Support for the amendments and newly added claims is found throughout the specification and claims as originally filed. For example, support for the nucleotide range 174 to 203 of SEQ ID NO: 3 is found in Table 1, which teaches a target site at nucleotide 174, and on page 11, line 35 and the claims as originally filed, which teach antisense oligonucleotides of 30 nucleobases in length. Support for the nucleotide range 174 to 193 of SEQ ID NO: 3 is found in Table 1, which describes a target site at nucleotide 174 and antisense oligonucleotides 20 nucleobases in length. Support for "8-nucleobase portion" (as recited in Claims 21 and 31) and "SEQ ID NO: 11" (as recited in Claim 33) is found in the claims as originally filed. No new matter has been added by way of these amendments.

Accordingly, following entry of the amendments submitted herewith, Claims 1, 5, 7, 9, 10, 12, 13, 15, and 21-40 are pending. Applicants reserve the right to prosecute canceled claims in a continuation application filed during the pendency of the present application. Reconsideration of the pending claims in view of the amendments and comments presented herein is respectfully requested.

#### *35 USC § 103(a) Rejection*

Claims 1, 5, 7, 9-13, and 15 are rejected under 35 USC § 103(a) over Rouy et al. in view of McLean et al. and Baracchini et al. The Examiner stated that "One of ordinary skill in the art would have expected success in making a non-cleaving antisense oligonucleotide targeted to a nucleic acid molecule encoding apolipoprotein(a) (SEQ ID NO: 3) since Rouy et al. provide the motivation to do so, McLean et al. taught the sequence of SEQ ID NO: 3 and Baracchini et al. taught that following generic teachings, the design and synthesis of modified antisense oligonucleotides to target a gene of interest can be made." The Examiner further asserted that "One of ordinary skill in the art would have expected success to inhibit the expression of apolipoprotein(a) (SEQ ID NO: 3) in cells or tissues *in vitro* because Baracchini et al. taught that following generic teachings, one could use antisense oligonucleotides to inhibit the expression of a known target gene."

DOCKET NO.: ISPH-0595  
Appl. No. 09/923,515

PATENT

Applicants respectfully disagree with the Examiner's assertion that the invention of Claims 1, 5, 7, 9, 10, 12, 13, and 15 would have been obvious to one of ordinary skill in the art, as a whole, at the time the instant invention was made. However, solely in an effort to advance prosecution, Applicants have amended Claim 1 to recite antisense oligonucleotides that are targeted to "a sequence within the range of nucleotides 174 to 203" of SEQ ID NO: 3. The combination of Rouy et al., McLean et al., and Baracchini et al. does not teach the antisense oligonucleotides that fall within the scope of amended Claim 1. Accordingly, Claims 1, 5, 7, 9, 10, 12, 13, and 15 as amended herewith are unobvious over the combination of Rouy et al., McLean et al., and Baracchini et al. For these reasons, the references fail to meet the standard of obviousness required under 35 U.S.C. 103(a) and Applicants respectfully request withdrawal of this rejection.

#### CONCLUSION

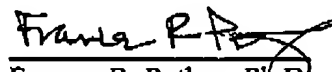
Applicant respectfully requests that the claim amendments submitted herewith be entered. In view of the foregoing amendments and remarks, Applicant submits that the application is now in condition for allowance and respectfully requests notification of the same.

The Director is hereby authorized to charge any deficiency in any fees due with the filing of this paper or during the pendency of this application, or credit any overpayment in any fees to our Deposit Account Number 50-0252.

Respectfully submitted,

Dated: February 22, 2006

By:

  
Frances R. Putkey, Ph.D.  
Agent for Applicant  
Registration No. 57,257  
(760) 603-2710